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The *Baranda* reference shows a flat belt for use in an elevator system.

The *Kilborn, et al.* technique cannot be used to make a belt as shown in the *Baranda* reference as suggested by the Examiner. The *Kilborn, et al.* reference includes using limited length sections of a fabric layer applied to a conveyor belt. If such a sectional, limited-length approach were used for an elevator belt, that would cause disruptions such as seams in the surface of the belt. Such disruptions would be even worse than the prior art elevator belt grooves that are disadvantageous as described in Applicant's background and shown in Applicant's Figure 1. The *Kilborn, et al.* technique is, therefore, not usable for making elevator belt assemblies like the one shown in the *Baranda* reference. Because the proposed combination does not provide a useful result, the proposed combination cannot be made and there is no *prima facie* case of obviousness.

Additionally, the *Kilborn, et al.* technique is not suitable for making the type of belt shown in the *Baranda* reference, in which cords are embedded in and spaced from the surfaces of the jacket material. The *Kilborn, et al.* reference requires, for example, that the cords rest on a table and then material is applied to the cords. See, for example, column 5, lines 35-36, 45 and 51-54. If one were to rest cords on the table as taught by *Kilborn, et al.* and apply a material to them while they are resting on that table, that would not allow for forming a jacket that is on both sides of the cords as required in the *Baranda* reference. The only way to utilize the *Kilborn, et al.* technique for hypothetically making a belt as shown in the *Baranda* reference would require significant reconstruction of the *Kilborn, et al.* technique, which would only be based on improper hindsight. The Examiner's proposed combination cannot be made because the *Kilborn, et al.* technique does not provide a result consistent with the *Baranda* reference and without a workable result, the combination cannot be made and does not establish a *prima facie* case of obviousness.

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Even if the combination could be made, the result is not consistent with Applicant's claims and there is no *prima facie* case of obviousness.

*Kilborn, et al.* teach an arrangement where individual weights 18 are suspended from clamping members 19 attached to cables. (Column 3, lines 48-50) Then, jaws of a clamping mechanism 11 clamp a group of cables so that the cables are clamped between the clamping mechanism 11 and the clamping mechanism 13. (Column 3, lines 27-31 and column 4, lines 2-4) Once a group of cables are clamped in two places, the individual weights 18 are removed from the cables. (Column 4, lines 5-6) The clamped portions are not tensioned in a controlled manner once the weights are removed. The clamped portions of the cords are not "individually" tensioned. Column 1, lines 36-38 and 60 teach that each of the tension elements in *Kilborn, et al.* have the same tension when they are clamped in position.

Only after the weights are removed and the cables are no longer individually tensioned, are the cables in the *Kilborn, et al.* reference "ready for the next operation, which is the application of the material which bonds the clamped sections of the stationary cables and cords together and provides a suitable body to which the fabric layers can be applied to form the completed tension section of the belt or at least enough of the tension section so that it can be wound upon a drum and then transferred to a position where the additional layers of fabric can be applied." (Column 5, lines 51-58)

Accordingly, *Kilborn, et al.* does not teach a technique for realizing at least two aspects of Applicant's claimed invention. One is that *Kilborn, et al.* can only apply a jacket to a limited section at a time and therefore introduces seams or interruptions in the applied material layer. That is not the same as Applicant's claimed technique that involves a generally smooth, uninterrupted surface on an exterior of the jacket.

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*Kilborn, et al.* also fail to teach maintaining tension on individual cords on an individual basis while applying a jacket material. Instead, *Kilborn, et al.* specifically teaches removing the weights that provided individual tensions and using clamping mechanisms that do not differentiate between the cords such that no individual tension on the cords is maintained any longer. This occurs before applying any material to the cords in *Kilborn, et al.* Accordingly, even if one made the combination proposed by the Examiner the result would not be the same as at least some of Applicant's claims. There is no application of a jacket material while maintaining tensions on the cords on an individual cord basis. Therefore, the proposed combination does not result in the claimed invention and there is no *prima facie* case of obviousness against Applicant's claims.

#### Claims 1 and 15

Claims 1 and 15 require maintaining a selected tension on each of the cords on an individual cord basis while applying the jacket such that the tension on the cords controls positions of the cords within the jacket. The *Kilborn, et al.* technique relies upon clamping the cords lying on a table to control the position of the cords relative to the material that is applied to those cords while they are stationary on the table. The *Kilborn, et al.* technique does not include maintaining a selected tension on each of the cords on an individual cord basis while applying the jacket. Instead, clamps are applied at each end of the table to hold all of the cords in place against the table. The *Kilborn, et al.* reference does not teach using tension as recited in claim 1 so that even if the combination could somehow be made, the result is not the same as the claimed invention.

#### Claims 3 and 4

Claim 3 includes steps of making a sample belt assembly, inspecting the sample belt assembly, determining whether the sample belt assembly is consistent with a desired configuration and adjusting the tension maintained on at least one of the cords if the determined configuration is

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not consistent with the desired configuration. This is nowhere in any way suggested or contemplated by the *Baranda* reference or the *Kilborn, et al.* reference. Even if those references could somehow be combined, the result would not be consistent with what Applicant recites in claim 3. There is no *prima facie* case of obviousness against that claim.

#### Claims 9 and 20

Claims 9 and 20 include forcing the jacket into a shaping device that ensures that the jacket exterior has a desired configuration and cooling the belt assembly. It cannot be obvious to do that in view of *Kilborn, et al.*'s teachings. In the *Kilborn, et al.* reference, successive layers are laid down upon the table beginning with the cords and then the bonding material. Later, fabric layers are applied. There is nothing about that process that in any way suggests there would be any benefit to incorporating a shaping device and cooling as recited in Applicant's claim 9 and 20. There is no *prima facie* case of obviousness against these claims.

#### Claim 16

Applicant's claim 16 includes maintaining different tensions on different cords. The *Kilborn, et al.* reference teaches the opposite. At column 1, lines 36-38 and 60, *Kilborn, et al.* state "it is very essential that each of the tension elements should have the same tension while being built into the belt." Using the same tension on every one of the tension elements or cords according to *Kilborn's* teachings is the opposite of what is recited in claim 16 and there is no *prima facie* case of obviousness against that claim.

The *Baranda* reference does not help the Examiner's case in this regard. There is no discussion in the *Baranda* reference regarding maintaining different tensions on different cords and even if it did, the Examiner proposes to use *Kilborn, et al.*'s technique, which is the opposite of what is recited in claim 16 as just explained.

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In addition to the reasons why there is no *prima facie* case of obviousness explained above, claim 24 includes further limitations that are not even suggested by the Examiner to be satisfied by the proposed combination of the *Baranda* and *Kilborn, et al.* references. Claim 24 includes using a molding device that has an opening through which the belt assembly proceeds, the opening comprising a non-linear configuration such that a thickness of the jacket exiting the opening varies across the width of the jacket. Not even the Examiner contends that these limitations are found in the proposed combination of the *Baranda* and *Kilborn, et al.* references. There is no possible *prima facie* case of obviousness against claim 24 even if those two references could be combined, which Applicant disputes as explained above.

Claims 28, 32 and 36

Claims 28, 32 and 36 include moving the cords while applying the jacket material. This technique is *impossible* if one were to use *Kilborn et al.*'s technique. As explained above, in that reference, the cords are clamped down in a fixed position on a table before the various layers are laid down. It is impossible to fix cords in a single position between two clamped ends that remain stationary on a table and move the cords at the same time. The Examiner's position regarding these claims has no connection whatsoever with the actual teachings of the reference and the rejection must be withdrawn.

Claims 29, 33 and 37

The Examiner completely misses ignores the references when rejecting claims 29, 33 and 37, which all include adjusting tension on a single cord while applying the jacket. The *Kilborn et al.* reference cannot possibly be used for such a method. That reference, as repeatedly explained above, requires the same tension on all cords and requires that the cords are clamped in a fixed

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position while fabric layers are added. It is completely impossible to adjust the tension on a single cord in that reference while applying a jacket. The only possible explanation for the completely unreasonable interpretation of the reference is impermissible hindsight. The rejection must be withdrawn.

The rejection of claim 2 under 35 U.S.C. §103 based upon the proposed combination of the *Baranda* and *Kilborn, et al.* references combined with the *Nassimbene* reference must be withdrawn.

As explained above, the *Kilborn, et al.* reference does not teach maintaining different tensions on different cords as recited in claim 2. The *Kilborn, et al.* reference teaches the opposite. The Examiner proposes to remedy this defect in the proposed combination of the *Baranda* and *Kilborn, et al.* references by adding the *Nassimbene* reference. Even that does not establish a *prima facie* case of obviousness against claim 2.

In the *Nassimbene* reference, different lengths and higher tension occur in the middle of a V-shaped, arched belt. Neither the *Kilborn, et al.* nor the *Baranda* reference would allow for or benefit from such a belt configuration. Therefore, there is no motivation for adding the teachings of the *Nassimbene* reference to the proposed combination of the other two references. Further, the *Kilborn, et al.* reference expressly teaches maintaining the *same* tension on every cord. To add the *Nassimbene* reference as proposed by the Examiner, therefore, would be directly contrary to the teachings of the *Kilborn, et al.* reference. Such a modification cannot be made and the proposed combination cannot possibly establish a *prima facie* case of obviousness against claim 2.

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The rejection of claims 5-7 under 35 U.S.C. §103 based upon the proposed combination of the *Baranda* and *Kilborn, et al.* references combined with the *Harper* reference must be withdrawn.

Claims 5-7 include a waxless urethane jacket material. There is no *prima facie* case of obviousness against any of these claims because none of the cited references disclose a waxless urethane jacket material. The *Harper* reference does not teach that its polyurethane material does not contain any wax. It is not a reasonable inference to assume that a special, waxless polyurethane would be used when conventional polyurethanes typically include a wax as one of the polyurethane components. In fact, the *Harper* reference teaches that a waxy mold release agent is present. Therefore, even if the proposed combination of these three references could be made, the result would not include a waxless urethane jacket material.

Additionally, the proposed combination of the *Baranda*, *Kilborn, et al.* and *Harper* references cannot be made. There is no benefit to adding *Harper's* teachings in the context of the *Baranda* or the *Kilborn, et al.* references. Where there is no benefit to a proposed combination, the combination cannot be made and there is no *prima facie* case of obviousness. In this instance, *Harper* uses a water-soluble barrier material added onto a mold surface that has already been coated with a waxy or oily release agent. The water soluble barrier does not in any way alter the wax-containing polyurethane but facilitates removing the waxy or oily release agent after the piece is molded. Such a barrier material has no use when making the belts of the *Baranda* or *Kilborn, et al.* references. The *Harper* reference teaches avoiding a film left by a waxy or oily release agent on the surface of a molding because the polyurethane article will be subsequently painted. The belts in the *Baranda* and *Kilborn, et al.* references *are not* painted and, therefore, the teachings of the *Harper* reference having nothing to do with the teachings of the other two references and there is no benefit

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for making the proposed combination. The Examiner's statement that the belts would be painted is without any support from the references or one skilled in the art and Applicants directly traverse that conclusion. Without any benefit, the combination cannot be made and there is no *prima facie* case of obviousness against any of claims 5-7.

The rejection of claim 8 under 35 U.S.C. §103 based upon the proposed combination of the *Baranda*, *Kilborn, et al.* and *Tsai* references must be withdrawn.

This proposed combination cannot be made. The *Kilborn, et al.* and *Baranda* references require a flat belt configuration. The molding device in the *Tsai* reference is intended to result in an article as shown in Figure 1 of that reference, for example. Such an article does not have a flat belt configuration. Therefore, the proposed combination goes directly contrary to the teachings of the *Baranda* and *Kilborn, et al.* references. In other words, the proposed combination cannot be made because it results in a belt that would not satisfy the primary reference(s)' requirements for a flat belt configuration.

Additionally, the *Tsai* reference is from an unrelated art and is not properly combinable with the *Baranda* and *Kilborn, et al.* references (even if it were somehow possible to provide the belts of either of those references with the cross-sectional configuration provided by the mold of the *Tsai* reference). There is no *prima facie* case of obviousness against claim 8.

The rejection of claims 14 and 41 under 35 U.S.C. §103 based upon the proposed combination of the *Baranda* and *Harper* references must be withdrawn.

As already discussed, the *Harper* reference does not disclose a waxless urethane as contended by the Examiner. Moreover, there is no benefit to the proposed combination and the references cannot be combined. The *Harper* reference is concerned with a polyurethane article that is painted after it is removed from a mold. There is no concern with painting the belt of the



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*Baranda* reference and, therefore, no benefit flows from the proposed combination. Even if the *Harper* reference could be strained to be interpreted as teaching a waxless polyurethane, it cannot be combined with the *Baranda* reference and there is no *prima facie* case of obviousness against claims 14 and 41.

The rejection of claims 17-18 under 35 U.S.C. §103 based upon the proposed combination of the *Baranda* and *Kilborn, et al.* references combined with the *Harper* reference must be withdrawn.

Claims 17 and 18 are allowable for the same reasons discussed above regarding the same impossible proposed combination of references. There is no *prima facie* case of obviousness because none of the cited references disclose a waxless urethane jacket material. The *Harper* reference does not teach that its polyurethane material does not contain any wax. It is not a reasonable inference to assume that a special, waxless polyurethane would be used when conventional polyurethanes typically include a wax as one of the polyurethane components. In fact, the *Harper* reference teaches that a waxy mold release agent is present. Therefore, even if the proposed combination of these three references could be made, the result would not include a waxless urethane jacket material.

Additionally, the proposed combination of the *Baranda*, *Kilborn, et al.* and *Harper* references cannot be made. There is no benefit to adding *Harper's* teachings in the context of the *Baranda* or the *Kilborn, et al.* references. Where there is no benefit to a proposed combination, the combination cannot be made and there is no *prima facie* case of obviousness. In this instance, *Harper* uses a water-soluble barrier material added onto a mold surface that has already been coated with a waxy or oily release agent. The water soluble barrier does not in any way alter the wax-containing polyurethane but facilitates removing the waxy or oily release agent after the piece is molded. Such a barrier material has no use when making the belts of the *Baranda* or *Kilborn, et al.*

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references. The *Harper* reference teaches avoiding a film left by a waxy or oily release agent on the surface of a molding because the polyurethane article will be subsequently painted. The belts in the *Baranda* and *Kilborn, et al.* references *are not* painted and, therefore, the teachings of the *Harper* reference having nothing to do with the teachings of the other two references and there is no benefit for making the proposed combination. The Examiner's statement that the belts would be painted is without any support from the references or one skilled in the art and Applicants directly traverse that conclusion. Without any benefit, the combination cannot be made and there is no *prima facie* case of obviousness against claims 17-18.

The rejection of claims 21-23 and 26-27 under 35 U.S.C. §103 based upon the proposed combination of the *Baranda* and *Harper* references must be withdrawn.

Applicant has already explained that the *Harper* reference does not teach what the Examiner contends. There is no teaching in the *Harper* reference of a waxless urethane material. Therefore, even if the combination could be made, the result is not what the Examiner contends and there is no *prima facie* case of obviousness.

Moreover, the combination cannot be made because there is no benefit to making it. There would be no benefit to the teachings of the *Baranda* reference to apply the *Harper* technique, which is directed to preparing an article for being painted. There is nothing about the belt in the *Baranda* reference that in any way suggests it would be painted. Therefore, there is no benefit and the proposed combination cannot be made.

Claim 26

Even if the *Harper* and *Baranda* references could be combined, there is nothing within them to suggest maintaining a selected tension on cords respectively while applying a jacket such that the tension on the cords controls positions of the cords within the jacket and the cords are

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uniformly spaced from a smooth, uninterrupted surface on the jacket along the length of the belt assembly. These limitations of claim 26 cannot be found even in the improper combination of the *Baranda* and *Harper* references. That is yet another reason why there is no *prima facie* case of obviousness against claim 26.

The rejection of claims 35 and 39 under 35 U.S.C. §103 based upon the proposed combination of the *Baranda*, *Harper* and *Pitts, et al.* references must be withdrawn.

First of all, the *Baranda* and *Harper* references cannot be combined for the reasons already given. The proposed addition of the teachings of the *Pitts, et al.* reference does not remedy the defect in the improper combination of the *Baranda* and *Harper* references. Moreover, the *Pitts, et al.* reference could only possibly qualify as prior art, if at all, against Applicant's claims under 35 U.S.C. §102(e). The *Pitts, et al.* reference and Applicant's claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. The *Pitts, et al.* reference and Applicant's application are commonly owned by Otis Elevator Company. Therefore, the *Pitts, et al.* reference cannot be used in an attempt to establish a *prima facie* case of obviousness pursuant to 35 U.S.C. §103(c). There is no basis in the statute for the Examiner's refusal to withdraw the rejection of claims 35 and 39. That rejection must be withdrawn according to the plain language of Title 35 of the United States Code §103(c).

#### CONCLUSION

There is no *prima facie* case of obviousness against any one of Applicant's claims. As explained above, the Examiner's various proposed combinations cannot even be made. Even if any of them could be made, the result would not be what the Examiner contends and would not be

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consistent with the claims against which the Examiner applies the improper combinations. All rejections must be withdrawn.

Respectfully submitted,

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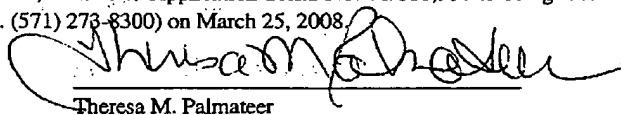


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CERTIFICATE OF FACSIMILE

I hereby certify that this Response, relative to Application Serial No. 10/010,937 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on March 25, 2008.

  
Theresa M. Palmateer

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